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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/699,983	11/03/2003	Anthony B. Eoga	PA00-1010-CIP-A	5318

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EXAMINER

ANTHONY, JOSEPH DAVID

ART UNIT

PAPER NUMBER

1714

DATE MAILED: 06/17/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

10/699,983

**Applicant(s)**

EOGA, ANTHONY B.

**Examiner**

Joseph D. Anthony

**Art Unit**

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) 11 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____.  |

## **DETAILED ACTION**

### ***Election/Restrictions***

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1-10, drawn to a process of coating a surface, classified in class 427, subclass 384.
  - II. Claim 10, drawn to an article of manufacture, classified in class 428, subclass 1+.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions I and II are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the process can be used to coat human hair on a live person which is clearly not an article of manufacture.
3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.
4. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

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5. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

6. During a telephone conversation with Steven B. Stein on 05/11/04 a provisional election was made with traverse to prosecute the invention of Group I, claims 1-10.

Affirmation of this election must be made by applicant in replying to this Office action.

Claim 11 is withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

***Claim Rejections - 35 USC § 112***

7. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

8. Claims 1-10 rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Independent claim 1 is deemed to contain new matter in regards to the limitation: "wherein the polyethylene oxide has a molecular weight greater than 250,000". It must be pointed out that the present application is a divisional application of parent application S.N. 09/751,160 filed 12/28/2000. A detailed examination the parent application shows absolutely no support for applicant's said

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polyethylene oxide molecular weight range of "greater than 250,000". The last line on page 8 through the first line on page 9 of the parent specification discloses polyethylene oxide of a molecular weight in the range of about 100,000 to 8,000,000. The same polyethylene oxide of a molecular weight in the range of about 100,000 to 8,000,000 is set forth on page 13, lines 13-17 of applicant's parent specification. If applicant desired to limit the polyethylene oxide molecular weight range too greater than 250,000 applicant will need to file another application as a CIP application.

***Claim Rejections - 35 USC § 102***

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

***Claim Rejections - 35 USC § 103***

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 1-3, and 8 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Roth et al. U.S. patent Number 5,418,006.

Roth et al discloses a method for coating a substrate surface with an aqueous composition comprising a film-forming substance, a water repelling substance and optional adjuvants such as surfactant. The coating can be removed with water and can be used to protect the coated surface from graffiti., see the abstract, column 4, line 28 to column 5, line 66, column 5, line 67 to column 6, line 6. Applicant's claims are deemed to be anticipated over Examples 4-5 wherein carboxymethylcellulose is used as the film-forming substance in the surfactant containing aqueous coating composition used to coat the substrate. In the alternative, Roth et al may differ from applicant's claimed invention in that it is unclear what the molecular weight is of the carboxymethylcellulose used in Examples 4-5. In the case that Examples 4-5 use a carboxymethylcellulose having a molecular weight that is outside of applicant's claimed range of "greater than 250,000" such would be obvious since carboxymethylcellulose agents are notoriously well known in the art to have molecular weights greater than 250,000, and such a molecular weight range is deemed to come directly within the broad disclosure of the patent. In any case the Examples 4-5 were given by way of illustration and not by way of limitation

12. Claims 4-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Roth et al. U.S. patent Number 5,418,006.

Roth et al has been described above and differs from applicant's claimed invention in that Example 4-5 do not teach the removal of the applied coating

from the surface. It would have been obvious to one having ordinary skill in the art to use the broad disclosure of Roth et al as overwhelming motivation to remove the coating from a surface if the coating was applied for such a purpose. Roth et al directly disclose such purposes, see column 5, line 67 to column 6, line 6.

13. Claims 1, 4-6, and 8-10 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Murayama U.S. Patent Number 5,401,495.

Murayama teaches a three-component system to whiten teeth and a method of its use. Applicant's invention is deemed to be anticipated over Example 4 when the "Polishing and Pigmenting Cream" is applied to the teeth of a person. It must be noted that the "Polishing and Pigmenting Cream" contains in part: carboxymethylcellulose 7MP and components that can be considered to be surfactants. In the alternative, Murayama may differ from applicant's claimed invention in that it is unclear what the molecular weight is of the carboxymethylcellulose 7MF component used in Example 4. In the case that the carboxymethylcellulose 7MF used in Example 4 has a molecular weight that is outside of applicant's claimed range of "greater than 250,000", it would be obvious to use another carboxymethylcellulose agent having a molecular weight greater than 250,000 since such molecular weight ranges are notoriously well known in the art, and such a molecular weight range is deemed to come directly

within the broad disclosure of the patent. In any case the Example 4 was given by way of illustration and not by way of limitation. Please note that since the outer surface of a tooth is not living tissue on which the "Polishing and Pigmenting Cream" is being applied, the Murayama method is deemed to read on applicant's claimed inanimate surface. Likewise, the taught applying step would result in some of the "Polishing and Pigmenting Cream" contacting the persons gums which is deemed to be the animate surface and is deemed to read on human skin.

14. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Murayama U.S. Patent Number 5,401,495.

Murayama has been described above and differs from applicant's claimed invention in that there is no direct teaching (i.e. by way of an example) to applicant's step of applying and additional amount of the composition on the surface. It would have been notorious obvious to one having ordinary skill in the art to apply additional amounts of the composition to a surface if such was desired to increase its thickness or for any number of other reasons. To apply more than one coating of the coating composition onto a surface cannot be considered to be inventive.

15. Claims 1-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sramek U.S. Patent Number 4,861,583.



Sramek teaches aqueous hot curling hair treatment compositions that comprise water soluble polyethylene oxide polymer that have a molecular weight between about 20,000 to about 250,000, see abstract and claim 1. The hair treatment compositions can be washed out of the hair with water at any time. Optional adjuvants are surfactants wetting agents, dyes perfumes etc., see column 3, lines 30-61. Sramek differs from applicant's claimed invention in that there is no direct teaching (i.e. by way of an example) to a method of using a hair treatment composition that actually comprises a water soluble polyethylene oxide that has a molecular weight of greater than 250,000.

It would have been obvious to one having ordinary skill in the art to actually make and use a hair treatment composition that contained a water-soluble polyethylene oxide polymer having a molecular weight greater than 250,000 since Sramek directly discloses and claims the use of polyethylene oxide within a range of between 20,000 and about 250,000. Sramek's use of the modifier "about" clearly expands Sramek's disclosure to encompass polyethylene oxides which have molecular weights somewhat in excess of 250,000. Please note that since external hair is non-living tissue on which the hair treatment composition is being applied, the Sramek method is deemed to read on applicant's claimed inanimate surface. Likewise, the taught applying step would result in some of the hair treatment composition contacting the persons scalp which is human skin and thus reads on applicant's claimed animate surface.

***Prior-Art Cited But Not Applied***

16. Any prior-art reference which is cited on FORM PTO-892 but not applied, is cited only to show the general state of the prior-art at the time of applicant's invention.

***Examiner Information***

17. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Joseph D. Anthony whose telephone number is (571) 272-1117. If attempts to reach the examiner are unsuccessful, the examiner's supervisor, Vasu Jagannathan, can be reached on (571) 272-1119. The centralized FAX machine number is (703) 872-9306. All other papers received by FAX will be treated as Official communications and cannot be immediately handled by the Examiner.



**Joseph D. Anthony**  
**Primary Patent Examiner**  
**Art Unit 1714**

6/4/04